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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,105	12/18/2001	Govindan Gopinathan	GOPI 0114 PUS	3534

7590 04/15/2005

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EXAMINER

NASSER, ROBERT L

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/024,105	GOPINATHAN ET AL.	
	Examiner	Art Unit	
	Robert L. Nasser	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-29,33 and 37-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8, 11, 13-29, 33, 37-76 is/are rejected.
- 7) ☒ Claim(s) 9,10 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The examiner notes that all of the current claims require at least 8 ekg sensors on one member. The parent applications only provide support for up to 6 on one member, with the other sensor on a second member. Therefore the current claims are not entitled to the filing date of the parent, and have only the current filing date, or December 18, 2001.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 5, 7, 10-15, 17-29, 47 and 70-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-94 of U.S. Patent No. 6224548 in view of David. The only difference in the current claims and the previous invention is that current claims require at least 7 electrodes. David shows a similar glove member with 12 EKG electrodes and other diagnostic devices. As such, it would have been obvious to modify the previous inventions to use 12 electrodes, as it is merely the substitution of one known diagnostic device for another. The exact arrangement of elements would have been obvious to one skilled in the art.

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Claims 1, 4, 5, 7, 10-15, 17-29, 47 and 70-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-100 of U.S. Patent No. 6248064 in view of David. The only difference in the current claims and the previous invention is that current claims require at least 7 electrodes. David shows a similar glove member with 12 EKG electrodes and other diagnostic devices. As such, it would have been obvious to modify the previous inventions to use 12 electrodes, as it is merely the substitution of one known diagnostic device for another. The exact arrangement of elements would have been obvious to one skilled in the art. 99

Claims 1, 4, 5, 7, 10-15, 17-29, 47, and 70-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6540673 in view of David. The only difference in the current claims and the previous invention is that current claims require at least 7 electrodes. David shows a similar glove member with 12 EKG electrodes and other diagnostic devices. As such, it would have been obvious to modify the previous inventions to use 12 electrodes, as it is merely the substitution of one known diagnostic device for another. The exact arrangement of elements would have been obvious to one skilled in the art.

Claims 1-5, 7, 10-15, 17-29, 47, and 70-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-64 of U.S. Patent No. 6595918 in view of David. The only difference in the current claims and the previous invention is that current claims require at least 7

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electrodes. David shows a similar glove member with 12 EKG electrodes and other diagnostic devices. As such, it would have been obvious to modify the previous inventions to use 12 electrodes, as it is merely the substitution of one known diagnostic device for another. The exact arrangement of elements would have been obvious to one skilled in the art.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 8, 16, 17, 33, 37-46, 48-69, and 73-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has recited in these claims that two of the electrodes face the dorsal surface of the member. It is unclear how one uses such electrodes to make an EKG measurement. In addition, it seems to contradict page 10 of the specification, where it states that the dorsally facing electrodes 40i and 40j are in the left and right shoulder quadrants. Clarification is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 7, 14, 15, 17-29, 47 and 70-72 are rejected under 35

U.S.C. 102(e) as being anticipated by David. David shows a glove (the shown embodiments appear to be the glove/sleeve combination, but it does state that it may be incorporated into only a glove) combination including 4 phalange portions, as thumb portion, a wrist portion, a palmer portion, and a dorsal portion, with 11 electrodes (counting the one of the sling) mounted on the device, a device 24 for communicating with remote monitoring equipment, and other diagnostic devices including a temperature sensor 44, a blood pressure measuring device 16 and 18, a pulse oximeter 36, a heart beat detector 38, and an auscultation device 50 and 52. All of the electrodes are on the palmer side of the glove (see column 5, line 54-58), with some on the wrist portion, some on the palmer surface and some on the phalange portions, including the pinky portion. Claims 70 and 71 are rejected in that David sows the recited method.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over David. Claims 11 and 13 are rejected in that applicant has not stated that the arrangement of the electrodes on the member glove solves a stated problem and has

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not stated that the arrangement is for a specific purpose. In addition, applicant has not shown any unexpected results from the recited arrangement. Hence, it would have been obvious to modify David to locate the electrodes as claimed, as it is merely a matter of design choice for one skilled in the art.

Claims 9, 10, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. These claims define that the index finger portion is at least as long as the middle finger portion. As applicant pointed out in his remarks, there is criticality to this design. None of the art shows this feature. As such, the claims define over the art.

Applicant's arguments filed 1/13/2005 have been fully considered but they are not persuasive.

With respect to the enablement rejection. The examiner sees wherein the specification the sensors 40i and 40j are discussed. However, the discussion still leaves the issue of how the sensors work unanswered. For example, are they reference sensors are the intended to pick up electrical signals from the hand.

With respect to the double patenting rejections, applicant has asserted that David is not similar to applicant's invention and that David teaches placing 5 electrodes on the sleeve and bicep portion. The examiner disagrees. Here, both the present invention and David teach glove members with ekg sensors thereon. As such, they are similar. In addition, the examiner notes that the sleeve and bicep portion is the wrist portion.

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In addition, applicant states that David does not teach that the present invention can be achieved. There is no requirement that David by itself teach the present invention.

With respect to the enablement rejection, applicant has pointed out where in the specification support for the limitations of the claims are. However, the examiner notes that the sections cited still do not answer the question of how those electrodes are used in an ekg measurement.

Applicant has asserted that David only shows a glove and sleeve combination. The examiner notes that such an arrangement is a "member contoured to the person's hand" and that nothing in the claims defines over this arrangement. The examiner once again notes that the sleeve portion is indeed the "wrist portion" noting that the term wrist is merely an intended use limitation and does not define over David.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser
Primary Examiner
Art Unit 3736

RLN
April 13, 2005

